

### **REMARKS / ARGUMENTS**

Claims 1-14 and 16-18 are pending in the patent application. Claims 1-13 and 16 stand rejected. Applicant acknowledges, with appreciation, the indication that claims 14, 17 and 18 are allowable. Applicant, again requests reconsideration and withdrawal of the rejections of claims 1-13 and 16 for the reasons below.

#### **I. Rejection under 35 U.S.C. 102(b):**

In the Final rejection of August 24, 2009, the Examiner has maintained the rejection of claims 1-13 and 16 as being anticipated by Ciotti (US **20030051417**).

1. The examiner has maintained the rejection under 35 USC §102 to claim 1, and dependent claims 2, 5-8, 11-13 and 16. The examiner considers that such claims are anticipated by Ciotti.
2. All of the claims that have been examined on the merit, by reason of the language of claim 1 and the claim dependencies, involve the following features.

“... in which the roof portion and/or the floor portion provide(s) structural integrity, the structural integrity being such that the building construction can be picked up by a crane, and/or arranged in a freight vehicle with a normally loaded freight container on top of it, in each case without causing structural damage to the building construction ...”

3. The Examiner has maintained this rejection even in view of the strong arguments presented in the response filed on August 3, 2009. While the Examiner has previously conceded that Ciotti does not specifically describe the above feature, the Examiner appears to be take the position that the feature is somehow inherent in the Ciotti disclosure. Applicant would like to bring to the attention of the Examiner that it is well settled that subject matter is inherent only when extrinsic evidence makes it clear that the subject matter necessarily (i.e., inevitably) flows from a disclosure of cited art. (*MPEP* 2112). This requirement is a prerequisite to invoking the doctrine of inherency and cannot be avoided. Consequently, inherency may never be

established by mere probabilities or even possibilities and the mere fact that a certain thing may be present (or may result) is always insufficient. (*MPEP* 2112).

We respectfully disagree and comment on each item of the examiner's reasoning as follows:

4. At page 2 of the report the examiner argues that –

“...a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art.”

5. Applicant would first note that this is **not** a recitation of intended use. The phrase noted by the Examiner is a statement clearly used to define the metes and bounds of the **structural integrity**, a claim structural limitation, provided by the defined structure. Further, the Examiner does not provide any authority for this proposition but if for arguments sake we accept it as valid the present language clearly meets the requirement. In this case, the claimed roof and/or floor portion which is/are formed to impart sufficient structural integrity to withstand crane lifting and/or stacking is clearly a structural difference **which is not at all mentioned or alluded to in Ciotti**.

6. At page 2 of the report the examiner goes on to argue that –

“If the prior art structure is capable of performing the intended use, then it meets the claim whether the prior art expressly discloses such use or not.”

7. While we may accept this legal proposition, we respectfully submit that the examiner has not been able to identify anything in Ciotti to suggest or imply that it involves the structural integrity feature of Applicant's claim 1 or is even capable of performing the so called intended use. To suggest that Ciotti embodies the structural integrity feature is purely speculative. If the examiner is able to identify something in the disclosure of Ciotti which makes inevitable the feature in question then please could the examiner direct us to the relevant language specifically, so that we can provide a more targeted response. We submit that the reality is that there is absolutely nothing in Ciotti to imply or make inevitable the relevant feature.

8. *Ciotti* is very much a 'top level' or 'generalized' disclosure and omits much detail. That is of course fine in terms of the concept actually claimed in *Ciotti* however it

does not follow from this that *Ciotti* would inevitably or otherwise be constructed in the manner of Applicant's claim 1. For example *Ciotti* could be constructed with reliance on temporary posts to give structural integrity or with reliance on some other internal arrangement altogether. *Ciotti* even fails to clearly define the materials of construction.

9. In light of the above we respectfully submit that the examiner's suggestion that *Ciotti* is "capable or performing the intended use" is without any foundation at all. With respect, the objection is purely a matter of speculation.

10. A page 2 of the report the examiner goes on to state –

"To overcome the reference the applicant must provide evidence that the claims provide a structure or distinguishing features that the reference does not have ..."

11. The examiner has not provided any authority for this proposition but in any case we submit that it is not problematic for the present application. We say this because the evidence of the difference is in the language of the Applicant's claims. The claims call for the structural integrity feature and there is nothing in *Ciotti* that discusses it or renders it inevitable. Again, *Ciotti* is only a top level disclosure and when implemented it could be constructed with reliance on temporary posts to give structural integrity or with reliance on some other internal arrangement altogether. There is absolutely nothing in *Ciotti* to suggest or imply that it be manufactured to have the structural integrity feature of the Applicant's claims.

12. At page 2 of the report the examiner argues that –

"Absent such a showing it is determined that *Ciotti* certainly is capable of the claimed structural integrity..."

13. With the greatest of respect applicant submits that the reasoning in the examiner's statement is fundamentally flawed. It in affect amounts to an allegation that a piece of art which is completely silent on a feature, and which has nothing to enable one to reasonably infer the presence of that feature, must be assumed to have the feature unless the Applicant proves otherwise! We respectfully submit that that is not a

correct statement of the law with regard to novelty. The authorities on this point are well established and in this regard we again refer the examiner to the benchmark test for anticipation as helpfully laid down in *Richardson v Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). In that case it was held that the alleged anticipation must be shown in as complete detail as is contained in the claim being assessed. In the present case the detail of the claim is set out in the quotation above, and there is very clearly no equivalent detail in Ciotti. In light of this claim 1 and thus all of its dependents clearly pass the *Richardson* test.

14. At page 2 of the most recent Office action the examiner argues –

“In the instant case applicant has not provided remarks, evidence or facts that demonstrate how the structure of applicant’s invention is capable of the claimed “integrity” while the prior art is not.”

15. With the greatest of respect, applicant submits that the above analysis is flawed. The Applicant’s claim 1 sets out the structural integrity feature in very clear language. It must therefore be accepted that the invention as claimed has that feature. Ciotti does not describe or have anything in its language to specifically state or infer the presence of the same feature and thus the language of the documents is itself evidence, in the words of the *Richardson* case, that Ciotti does not disclose the feature in as complete detail as is contained in the claim.

16. Applicant, respectfully, submits that the examiner’s analysis in affect amounts to raising a rejection without a proper prima facie foundation and suggesting that the Applicant has the burden of disproving it. Applicant believes it is firmly established, that the Examiner (or USPTO) must first come forth and establish a prima facie case before the burden of proof shifts to applicant to prove anything. Applicant submits that the Examiner’s efforts to shift the burden to applicant is contrary to *Richardson* and to well established doctrine generally. It places an unfair and unnecessary burden on an Applicant.

17. At page 4 of the most recent Office action, the examiner appears to suggest that the structural integrity feature is found at paragraphs 006 and 0023-0025 of Ciotti.

However on reading those paragraphs we are not able to find anything describing the structural integrity feature at all, and nothing which makes it inevitable or inherent in the structure described from the language used in those paragraphs. If the examiner considers that those paragraphs teach the feature in question, it is requested that the examiner provide reasoned analysis as to how this disclosure reasonably describes the feature, and claim limitation, in question. However we trust that the comments we have provided above have already resolved this issue. Notwithstanding this we note that paragraphs 006 and 0023-0025 do not mention the use of a swinging wall or floor to provide the requisite structural integrity or in any manner suggest that structural integrity is even a concern to be dealt with. If it is there, Ciotti does not appreciate the need, advantage or desirability and does not provide any information which would reasonably suggest that the described structure has any particular level of integrity or should have such a level provided by any means. Applicant submits that this does not amount to a disclosure in as complete detail as is contained in the claim (*Richardson v Suzuki Motor Co*).

18. For these reasons and as discussed in more detail in the previous response, applicant, respectfully, submits that as claim 1 defines novel subject matter the rejection is equally inappropriate to those claims dependent thereon and is therefore rendered moot. Reconsideration and withdrawal is requested.

## **II. Rejection under 35 U.S.C. 103(a):**

### **Rejection over Ciotti in view of Abler (20060185262):**

### **Rejection over Ciotti in view of Morris (5966956):**

### **Rejection over Ciotti in view of WO 9802626:**

19. The Examiner has also raised obviousness rejections against claims 3, 4, 9-10 and 12. These rejections and the reasons they should be withdrawn are extensively discussed in the response filed August 3, 2009. The basic premise for each of these rejections is

that claim 1, from which these claims depend, lacks novelty in view of Ciotti. This is clear because the rejection analysis deals with the feature of the dependent claim in each case, and not claim 1. Our above submissions in relation to novelty clearly demonstrates that claim 1 is novel regardless of Ciotti within the meaning of 35 USC 102(b) and we respectfully submit that this renders the obviousness rejections moot. Reconsideration and withdrawal is hereby requested.

20. While the examiner has not raised an obviousness objection in relation to claim 1 we note that none of the prior art suggests or teaches the structural integrity feature discussed in relation to the novelty rejection which is missing from Ciotti.

#### **GENERAL**

21. We accept that the examiner is not bound by decisions made by other Patent Offices but we respectfully submit that the corresponding Australian and New Zealand cases have proceeded to grant of patent. The granted claims for these can be viewed online at the respective Patent Office web site links indicated below. It is submitted that the grant decisions in Australia and New Zealand are at least persuasive in favor of the present US case.

Country	Number	Link
New Zealand	532620	<a href="http://www.iponz.govt.nz/cms/banner_template/IPPATENT">http://www.iponz.govt.nz/cms/banner_template/IPPATENT</a>
Australia	2005220275	<a href="http://pericles.ipaustralia.gov.au/aub/pdf/nps/2007/0215/2005220275B2/2005220275.pdf">http://pericles.ipaustralia.gov.au/aub/pdf/nps/2007/0215/2005220275B2/2005220275.pdf</a>

#### **CONCLUSION**

Applicant has provided a response to the Examiner's position taken in the Final rejection of August 24, 2009. Reconsideration and withdrawal of all grounds of rejection is requested.

Should any official at the United States Patent and Trademark Office deem that any further action by the Applicant or Applicant's undersigned representative is desirable and/or necessary, the official is invited to telephone the undersigned at the number set forth below.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 CFR §§ 1.16-1.17 or credit any overpayment, to deposit account No. 503321. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, or otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 503321.

Respectfully submitted,

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